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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/748,122	Applicant(s) WEXELBLAT, DAVID ELI	
	Examiner Prieto Beatriz	Art Unit 2142	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 31 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



***DETAILED ACTION***

1. This communication is in response to Amendment filed 4/13/06, claims 1-47 remain pending

***Claim Objection***

2. Claim objection regarding claim 13 has been obviated by amendment thereto and thereby withdrawn. Claim (29) limitation recites “receive *out-of-band communications*, ...where the *out-of-band communication*...”, where the out-of-band communication seems to lacks antecedent basis. Correction is required.

3. Claims 29, 32, 36-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In this case, Applicant has indicated (p. 14 of remarks) that “support for the new claims may be found in the application at least on page 10, line 5 to page 11, line 2”. The Office appreciates the indication. However, supportive written description for added limitation(s) on claims 13, 29, 31, 32, 36, 37, and 41 is not clear. Specifically, the claimed terms “email channel” and “instant messaging channel” seem to lack antecedent basis in specification as filed, if applicant can point out where are these terms recited, it will be full appreciated and considered. Nevertheless, the specification has been reviewed for supportive disclosure for the added limitation, namely, wherein the out-of-band communication indicated that the communication

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user should be permitted to received e-mails from the expected communications sender over an e-mail channel or should be permitted to receive instant messages from the expected communications sender over an instant messaging channel.

In an effort to try to identify where in the specification there is written description that would shows support for added limitation, the term instant messaging or instant message has been search in hope relevant portions describe this added limitation have been made.

Invention's specification has been reviewed for any recitation of instant messaging channel, however the following passages only recite "instant message", there seems no recitation of an "instant messaging channel":

[0005] Further, upon receipt of a communication from the expected communications sender, the communication may be sent to the intended communications recipient. The received communication may be an e-mail, an instant message, a telephone call, or a message posted to an online message board. After sending the communication to the intended communications recipient, the identifying information for the expected communications sender may be deleted from the white-list associated with the intended communications recipient. The intended communications recipient also may be notified that the expected communications sender is scheduled to be removed from the white-list. In such a case, the intended communications recipient may be asked whether the expected communications sender should be kept in the white-list.

[0035] FIG. 1 is a high-level block diagram of one implementation of a transactional white-listing system 100 incorporating CSPA communications system 102, CSPB communications system 104, and third-party service provider system 106. In the shown implementation, CSPA communications system 102 includes CSPA communications server system 108 and communications application system 110. CSPA communications server system 108 is configured to facilitate electronic communications between a subscribing CSPA user and other entities and persons. These communications often occur over the Internet or the Web. The communications may involve e-mail, instant messaging (IM), chat or message boards, voice mail, caller identifier (ID), or any facilitated peer-to-peer communications. For example, in an instant messaging environment, CSPA communications server system 108 is configured to facilitate instant messaging between users. In a voice mail context, CSPA communications server system 108 is configured to provide voice mail services.

[0036] Communications application system 110 is identifiable to CSPA communications server system 108, and is configured to send and receive electronic communications using the services provided by CSPA communications server system 108. Communication application system 110 is shown separately from CSPA communications server system 108 solely for explanation purposes. It may form an actual part of the CSPA communications server system 108, as with some web-based CSPs, or it may be a separate client-side component identifiable to CSPA communications server system 108 over a network or the Web. In the above example of instant messaging, communication application system 110 is an instant messaging application running on central servers or client devices.

[0088] As explained above, the transactional white-listing systems and methods can be implemented in many different contexts, such as ID systems, caller ID systems, and message or chat board systems. In an IM

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system, for instance, instant messages sent to a particular intended recipient may be filtered through a global white-list maintained by an IM host system and/or a personal white-list associated only with the particular intended recipient. The personal white-list may be stored by the IM host system or the local IM client running on the computer or other IM-enabled device (e.g., cell phone, personal digital assistant) used by the particular intended recipient. In one implementation, CSPA communications server system 108 (see FIG. 1) is the IM host system and communications application system 110 is the IM client system of the intended recipient. Likewise, CSPB communications server system 114 is an IM host system, which may be the same or a different IM host system than the IM host system used by the intended recipient. A third-party service provider system thus can effect the transactional white-listing of an IM user through sending an out-of-band communication to the IM host system associated with the intended recipient. Examples of IM systems include, but are not limited to, AIM (America Online Instant Messenger), Yahoo Messenger, MSN Messenger, and ICQ. Additional information on IM systems may be found in "How the Internet Works" by Preston Gralla, which is incorporated by reference.

The above portions, in this case, at least those that recite "instant message" or "instant messaging", do not seem to provide a clear written description of where: *the out-of-band communication indicated that the communication user should be permitted to received e-mails from the expected communications sender over an e-mail channel or should be permitted to receive instant messages from the expected communications sender over an instant messaging channel;*

Thus, the broadest reasonable interpretation inlight of the specification will be applied. Namely, the out-of-band communication indicated that the communication user should be permitted to received communication from the expected communications sender, the recipient receiving out-band communication according to said indication, wherein the out-of-band communication includes email messages and instant messages. For the purposes of examination the claimed "email channel" and instant messaging channel" are just channels and/or a first and a second channel. According to the disclosure of instant application it seems that "channels may simply be any connection over a network, the Internet, or the Web" [see specs 0044].

***Claim Rejection under 35 U.S.C §103***

4. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action

5. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Pickup (US 2003/0212791) in view of Brown et. al. (US 2002/0078158) (Brown hereafter)

Regarding claim 1, Pickup teaches a sender sends communication to the recipient Fig. 2 and sending to a recipient said communication (Fig. 2);

said communication intended to a recipient contains information identifying a sender, e.g. a sender address [0003];

determining whether said information identifying said sender of said communication appears in a list associated with said recipient, and identifying in response to said determination that said sender does not appear in said list associated with said recipient [0024, 0037];

in response to identifying that said sender does not appear in said list associated with said recipient, forwarding a request for verification [0025-0026];

adding the information identifying the sender to said list in response to a received verification from the sender in response to said identifying that the sender does not appear in said list [0026, 0040, 0058], however Pickup does not explicitly disclose a first communication channel distinct from a second communication channel through which recipient receives a communication;

Brown discloses an email server for storing messages for viewing upon client's request [006], including

sending by a sender (12 of Fig. 1) a communication to an intended recipient over a first communication outbound channel (22 of Fig. 1) and receiving communication over a second inbound channel (35 of Fig. 1) distinct from the first (abstract), and

sending by a sender (312 of Fig. 4) a communication to an intended recipient over a first communication outbound channel coupled to a network, said first communication channel is another channel than the channel through which the communication was received from intended recipient (342 of Fig. 4) coupled to said network;

wherein the communication (correspondence) contains an email address [0006], wherein an outbound email message intended to a recipient comprises a destination address and information regarding the intended recipient [0079], having "to" and "from" fields [0129].

It would have been obvious to one of ordinary skilled in the art at the time the invention was made given the suggestion of Pickup for communicating email between users, the teachings of Brown for communicating media enhanced emails between users, would be readily apparent. One of ordinary skill pertaining e-mails or electronic messaging systems would recognize, that once a sender sends an e-mail message to an intended recipient (i.e. recipients email address), the intended recipient at client terminal, performs the action of logging on to a corresponding email server for accessing his/her e-mail, and thereby the recipient is able to read any e-mail messages that might have been addressed to him or her at that e-mail address. One would be motivated to combine these teachings because in doing so email can be enhanced with multimedia content with out requiring a separate application operable with standard email servers.

6. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickup in view of Brown in further view of JUDGE (US 2003/0172294)

Regarding claim 2, however the above-mentioned prior art do not explicitly teach deleting identifying information for the sender from the white list associated with a recipient after an elapsed period of time.

JUDGE teaches a triggering deletion of the identifying information for the expected communications sender from the white list associated with the intended communications recipient at a predetermined time [0166]. Additionally, teaching determining regarding received/out-of-band communication [0051] whether the identifying information for the expected communications sender appears in a white-list associated with the intended communications recipient [par 0033; 0048, 0057, and Fig. 10] and adding the identifying information for the expected communications sender to the white-list associated with the intended communications recipient in response to a determination that the identifying information for the expected communications sender does not appear in the white-list associated with the intended communications recipient [see par 0057, 0102, 0162, 0183 and Fig. 10]; including adding automatically identifying information from the sender to a whitelist [0174], including

sending a communication to an intended recipient over a first communication outbound channel and receiving communication over a second inbound channel distinct from the first [0131-0132].

It would have been obvious at the time the invention was made given the teachings for preventing the reception/transmission of email to unauthorized senders the teachings of JUDGE



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for detecting and preventing the delivery of unsolicited email communication would be readily apparent. One ordinary skilled in the art would be motivated to receive an electronic communication directed to or originating from an email server (that is, for example in response to an action by a sender who send a communication to an email server or in response to an action by a recipient who is accessing a communication from an email server), testing (determining) the received communication to compare the sender's identifying information, e.g. address in the received communication to addresses contained in one or more white-list [see par. 0048], as taught by JUDGE to prevent a recipient from receiving unsolicited email.

Regarding claims 3-5, the identifying information for the expected communications sender is an e-mail address for the expected communications sender [Pickup: 0011, 0013]; and an IP address [Brown :0189].

Regarding claim 6, determining whether recipient appears in a white-list associated with the expected communications sender; and adding the identifying information for the intended communications recipient if said recipient does not appear in the white-list associated with the expected communications sender [Pickup: 0026, 0040, 0058].

Regarding claims 7-8, upon receipt of a communication from the expected communications sender, triggering the sending of the communication to the intended communications recipient, wherein the received communication is one of an email message [Pickup: 0026, 0040]; email, instant message and phone call [Judge: 0055]

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Regarding claims 9-12, upon sending the communication to the intended communications recipient, triggering deletion of the identifying information for the expected communications sender from the white-list associated with the intended communications recipient [Judge: 0166]; email, instant message and phone call [Judge: 0055]

7. Claims 13-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickup-Brown in view of Duvall et. al. (US 5,884,033) (Duvall hereafter) in further view of Paul (US 5,999,932).

Regarding claim 13, comprising limitation similar to those applied on claim 1, same rationale of rejection is applicable, including receiving an out-of-band communication from a service provider over a said communication channel [Pickup: 0061];

determining whether said information identifying said sender of said communication appears in a list associated with said recipient, and identifying in response to said determination that said sender does not appear in said list associated with said recipient [Pickup: 0024, 0037];

Brown teaches sending an out-of-band communication generated by a communication sender (312) over an out-of-band communication channel (315) for delivery to an intended recipient; and receiving an out-of-band communication (e.g. an email) generated from a user on PC (312 e.g. a sender) from a service provider (e.g. 330 and/or 320) over an communication channel (338 and/or 326) and receiving by the intended recipient the out-of-band communication over a communication channel different than the communication channel

through which the sender sent the out-of-band communication; however the above mentioned prior art does not teach determining if a host has a list used for filtering email.

Duvall in the same field of applicant's endeavor teaches filtering incoming or outgoing messages using stored filters comprising listing associated with a predetermined action to be applied to the said incoming or outgoing messages (col 4/lines 23-37). Specifically,

determining if a host has a list used for filtering email, by searching a database for filters based on the incoming or outgoing message, said database containing a list of filters (col 4/lines 38-55) and email-filtering list having entries containing expiration date, frequency of update, and identification of the filter set (col 7/lines 41-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestions of Pickup for filtering inbound and outbound email the teachings of Duvall for filtering email by determining whether to block or allow incoming and/or outgoing messages using a filter database having a list of filters software implemented on the client or server system and further applicable to firewall, gateways or proxy servers, as taught by Duvall. One of ordinary skill given the suggestions of Duvall for maintaining an expiration data associated with said filtering list entries as means for updating and/or purging respective entries in the filter list. Entries are examined to determine if the expiration date/time been reached when compared with the current date/time or alternatively, the expiration date/time may represent a "time to keep" value stored in respective entry using a creation or received date with which to compare, regardless of the detection mechanism upon determining that the entry is stale, the entry is either updated or purged. One would be motivated to apply theses teachings to the Pickup system because in doing so different specified blocking options, including discarding

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incoming and/or outgoing message can be applied using various portions of the email other than addresses, as suggested by Duvall. However, the above-mentioned prior art does not teach where the adding is performed automatically.

Paul teachings in the same field of applicant's endeavor teaches automatically adding information identifying the sender from a communication received from a service provider to a list (Paul: col 5/line 5-17, col 6/lines 20-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestions of Pickup for filtering inbound and outbound email the teachings Paul would have been readily apparent. One of ordinary skilled in the art would be motivated to apply the teachings of Paul for automatically updated inclusion list, to overcome the drawback of the prior which require manual update, Paul teaches using e-mail messages received from sources other than those on the automatically updated inclusion list, thus, making it possible to eliminate virtually all of unsolicited e-mail messages and is not vulnerable to changes in the unsolicited e-mail origin addresses.

Regarding claim 14-15, automatically adding information identifying the expected e-mail sender and a transactional identifier to the white-list includes adding a indicator which permits handling of mail (e.g. an identifier or address [Pickup: 0026, 0040, 0058 and Judge: 0174]).

Regarding claim 16, this method claims comprises substantially the same method steps/acts as those discussed on claims 1-2, 6, 13 and 15 discussed above, same rationale of rejection is

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applicable. Further including importing a whitelist from a third party service provider [Judge: 0036, 0146-0148].

Regarding claim 17, this claims comprises limitations substantially the same as those discussed on claim 14, same rationale of rejection is applicable.

Regarding claim 18, this comprises substantially the same limitation(s) discussed on claim 14, same rationale of rejection is applicable.

Regarding claims 19-26, time stamp means for performing expiration time [Judge: 0166, 0208].

Regarding claims 27-28, corporation's local network [Judge: 0023], RPC [Judge: 0182].

Regarding claim 29, substantially the same as claims 1, 13 and 16, where a gateway received emails from a service provider [Judge: Fig. 1, external providers 170, to local clients 130 through firewall, i.e. gateway 140] and

a client communications sender (312/314 of Fig. 4) configured to send an out-of-band communication over an first out-of band communications channel for delivery to an intended communications recipient (342 of Fig. 4) [Brown 0078-0079]; a first computer (320) configured to received sent out-of-band communication over the first out-of-band communications channel from the client communications sender [Brown 0079];

receiving over a second communication channel other than the first out-of-band said out-of-band communication by which the out-of-band communication was sent by the client communications sender the out-of-band communication at the intended recipient [Brown 0079];

a second computer “gateway” configured to receive sent out-of-band communication over a third out-of-band communications channel from the first computer (e.g. email server) [Judge: 0051, second computer see 0049 including a gateway see 0036 or firewall see 0089];

the second computer configured to determine where the out-of-band communication indicates that the communications user (recipient) that should be permitted to receive communications from predefined communication sender, i.e. “an expected communications sender” [0051], where the out-of-band communication comprises email message and instant messages [Judge 0055, 0126] was received by the intended recipient over an communication channel other than the communication channel through which the out-of band communication channel was received [Judge Fig. 4], where the out-of-band communication comprises instant messages [Judge 0055];

wherein the out-of-band (email) communication indicated that the intended recipient should be permitted to receive the out-of-band communication from the expected communication sender [Judge 0051] where the out-of-band communication comprises email message and instant messages [Judge 0055, 0126]; where the out-of-band communication was received by the intended recipient over an communication channel other than the communication channel through which the out-of band communication channel was received [Judge Fig. 4 Brown Fig. 3],

if the out-of-band (email) communication indicates that the intended recipient should be permitted to receive the out-of-band communication from the expected communication sender [Judge 0051] where the email message [Judge 0055, 0126] is received by the intended recipient over an communication channel other than the communication channel through which the out-of band communication channel was received [Judge Fig. 4 Brown Fig. 3];

if the out-of-band (instant message) communication indicates that the intended recipient should be permitted to receive the out-of-band (instant message) communication from the expected communication sender [Judge 0051] where the email message [Judge 0055, 0126] is received by the intended recipient over an communication channel other than the communication channel through which the out-of band communication channel was received [Judge Fig. 4 Brown Fig. 3]; and

a second computer “gateway” configured to receive sent out-of-band communication over a third out-of-band communications channel from the first computer (e.g. email server) [Judge: 0051, second computer see 0049 including a gateway see 0036 or firewall see 0089];

Regarding 30, users explicitly list users from whom email is desired [0036].

Regarding claim 31, substantially the same as claims 1, 13 and 16, claimed term “temporarily permit”, given the broadest reasonable interpretation reads on permitting, thereby, whitelist, inclusion or allow list and blacklist, exclusion or reject list of the prior art are equally applicable, and further suggesting where temporarily comprises a predetermined time “window” (Paul: col 5/lines 19-31).

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Regarding claim 32, this claim is substantially the same as claims 1, 13, 16 and 31 and rationale set forth thereon, comprising combined whitelist and blacklist filtering.

Regarding claim 33-35, these claims are substantially the same as claims 1-2, 11 and 13-14, same rationale of rejection is applicable.

Regarding claims 36-37, these claims are substantially the same as claim 8, same rationale of rejection is applicable and further added limitation(s) substantially the same as those added to claims 1, 13, 16 and 31, same rationale of rejection is applicable.

Regarding claim 38, this claim is substantially the same as claims 1, 13 and 16, same rationale of rejection is applicable.

Regarding claims 39-40, whitelist is maintained on a local device such as personal computer [Judge: 0036].

Regarding claims 41-42, these claims comprise limitation substantially the same as those discussed on claims 1-2, 13, 16, where the whitelist thereon is the same as the “list of approved senders” hereon and the service provider thereon is the same as the “authorized source” hereon, same rationale of rejection is applicable.



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Regarding claims 43-45, the first channel other than the second channel comprises a network channel (called virtual private) (Judge: Fig. 4 network 150 of Fig. 2); the second channel comprises an HTTP channel (Judge: 0126).

Regarding claim 46-47, the out-of-band communication originates at the service provider (Brown: see 0079, see 0083] and the out-of-band communication originates at a source (called “authorized”) (Brown 0079).

***Citation of Pertinent Art:***

8. The following prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. Copies of Non-Patent Literature documents cited will be provided as set forth in MPEP§ 707.05(a):

RFC 2822: Internet Message Format, Resnick, P., April 2001.

Resnick discloses an out-of-band communication such as an email message comprises a header portion *identifying the sender and identifying the recipient* (section 3.4 on p. 15)

MASTERING OFFICE 97 Professional ed, Microsoft, Moseley, L.E., et. al., Sybex Inc., 1997, ISBN 0-7821-1925-5, Chapter 33-The Basics of Outlook, p. 753-764.

Mosely discloses the Outlook bar on Fig. 33.1 showing command icons to navigate through the application including an Inbox Folder (p. 757). The Inbox Icon on Table 33.1 listing Outlook icons and their function illustrates the INBOX icon which allows users to view the content of their Inbox folder (p. 758). The INBOX folder on table 33.2 illustrates where the function of the Inbox icon allows the user to receive incoming mail (p. 759)

Using Netscape 2™, Special Ed, Brown, M.R., QUE® Corporation, 1995, Jan 1996, Chapter 13: Email with Netscape, p. 327-352

A user accessing his/her email account to access the corresponding mail browser window (p. 336 Fig. 13.7) in response to a user entering a password and clicking the OK button, wherein in response to this user's action the email client application logs on the user's respective email server; displaying a mail screen in response to the above user's action, the display including a list of folders including an INBOX folder (left top of Fig. 13.8 on p. 337) and a listing of messages headers for every incoming email message (on the right top of Fig. 13.8 on p. 337), the INBOX folder may open by default when the mail facility is opened. The email from the displayed email listing is open by double-clicking on them (see Note on page 336). That is, in response to a user action opening for viewing one of the listed incoming mail messages, wherein in response to the user's action of double clicking on a selected incoming mail message from the listing of incoming email message, the bottom of the screen will display the text of the opened message (see p. 336).

### *Response to Arguments*

9. Regarding claim 1 rejected under Pickup in view of Brown as being unpatentable, it is argued (p. 14-15 of remarks), the neither of these references teach claim limitation as recited. Specifically, "in response to an action by an intended communications recipient, receiving an out-of-band communication from a service provider", as recited on claim 1.

In response to the above argument, applicant's interpretation of the applied references has been carefully reviewed. Pickup teaches in response to an action by an intended communications recipient using email client applications, receiving an out-band communication from a service provider. Specifically, wherein the service provider (e.g. e-mail server) in response to a black-list built by the recipient including adding the addresses or characteristics of unwanted email thereto, where the list is used by the server to crosscheck incoming (inbound)

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messages against the list sending unwanted email to user's trash or deleted folder, thus desirable or wanted email is provided to the recipient [see 0003, 0061, a white-list is equally applicable see 0058]. Pick teaches where these blacklists are only reactive in nature; it is necessary to nominate the unwanted address before it can be blocked, such as action by the recipient of adding addresses or characteristic of unwanted email [0058]; a recipient dials into an Internet Service Provider (i.e. over a communication channel) to receive email messages [see Judge 0028 and 0017].

Pick teaches in response to an action by an intended communications recipient, receiving an out-of-band communication from a service provider, particularly, wherein unauthorized electronic mail is intercepted before entering into a network associated with the recipient, and advantageously prevents the corresponding reduction in bandwidth caused by unwanted electronic mail passing through the network associated with the recipient [0017], thus unwanted email is not provided to the recipient through the network associated with the recipient.

Thus, Pickup discloses in response to an action by an intended communications recipient, receiving an out-band communication from a service provider.

The broadest reasonable interpretation in light of the specification (see MPEP § 2106/2111) has been applied to argued claim limitation, namely, *"in response to an action by an intended communications recipient, receiving an out-band communication from a service provider"*. Applicant is urged to amend the claim language if the claim is not to be interpreted as noted above.

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10. Regarding claims 2-12 rejected under Pickup in view of Brown in further view of Judge as being unpatentable, it is argued (p. 15-16 or remarks), it is argued that Judge does not teach *in response to an action by an intended communications recipient, receiving an out-band communication from a service provider*.

In response to the above argument, given that the argument presented with respect to claims 2-12 which depend from claim 1, argue the claim limitation of claim 1, discussed above, same response is applicable.

11. Regarding claim 13, rejected under Pickup-Brown in view of Duvall and Paul, it is argued (p. 16-17 of remarks) that the applied references do not teach claim limitation as amended. Specifically, *receiving an out-of-band communication from a service provider over an out-of-band communication channel, the out-of-band communication identifying an expected email sender different than the service provider*. Thus, the argued point [AS BEST UNDERSTOOD] is that the references do not teach an email from a sender received by a recipient via a service provider.

In response to the above argument, the Brown patent on Fig 4, illustrates an e-mail messaging system (300) including: a user PC (312), which supports an e-mail client (314) [see par 0078], when the user working on user PC (312) (i.e. email sender) *originates an outbound e-mail message* (not shown) processed by the client application (314) and intended for delivery to an intended recipient, the outbound e-mail message is sent from the user PC (312) to the server (320) over an outbound path (315) i.e. communication out-of-band channel;

receiving the outbound email message over the outbound channel (315) at server (320), the outbound email message is process (to eventually add rich media content to the outbound e-mail message) sent to another application (330) which then utilizes the information in the outbound e-mail message received and constructs an rich media e-mail (334) according to information contained in the outbound e-mail message, this rich media e-mail 334 includes the content of the original, outbound e-mail message and information regarding the original, intended recipient. The Rich media e-mail 334 is then directed via Internet 18 to a recipient 342 over communication channel (338), which is the original, intended recipient [see 0079], wherein the processing application (330) may integrated into server (320) [see 0083].

Brown teaches sending an out-of-band communication generated by a communication sender (312) over an out-of-band communication channel (315) for delivery to an intended recipient; and receiving an out-of-band communication (e.g. an email) generated from a user on PC (312 e.g. a sender) from a service provider (e.g. 330 and/or 320) over an communication channel (338 and/or 326).

Figure 19 illustrates an graphical user interface (e.g. Microsoft Outlook) through which a user access email, one of ordinary skill in the art would recognize that the listing once the INBOX is clicked on includes the viewing the sender of each email in the email listing. Evidence has been provided on the record see pertinent prior art listing with this respect. Thus, an out-of-band communication (e.g. an email constructed by a sender) sent to an intended recipient, identifies the email sender which is different than the service provider from which the email recipient received the out-of-band email.

More particularly, base on the fact that recipients in the Brown patent seem to obtain their

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emails through an INBOX – Microsoft Outlook application to reasonable determine that the received out-of-band communication (e.g. an email constructed by a sender) sent to an intended recipient, and displayed on Figure 19 on the INBOX window identifies the email sender which is different than the service provider from which the email recipient received the out-of-band email.

The claim limitation, *an out-of-band communication identifying an expected email sender different than the service provider* is an inherent characteristic necessarily flowing from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. App. & Inter. 1990), see MPEP 2112 IV (8<sup>th</sup> ed. Rev. 3), and/or see additional supportive pertinent prior art of record listed below.

Thus, Brown teaches receiving an out-of-band communication from a service provider over an out-of-band communication channel, the out-of-band communication identifying an expected email sender different than the service provider.

Brown further teaches wherein in general, e-mail client 314 generates an outbound e-mail message, and forwards the outbound e-mail message to mail server 16 (over a communication channel); the Mail server 16 then directs the outbound e-mail message to routing application 322 for processing where the outbound e-mail message is further processed to generate rich media e-mail (334) including to the original text in the outbound e-mail message, where email (334) is then directed via Internet 18 to recipient 342, which is the original, intended recipient over communication channel (338) [see 0081].

Thus, Brown teaches receiving an out-of-band communication generated from a sender

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through a service provider over an out-of-band communication channel. The out-of-band communication viewed via Inbox – Microsoft Outlook interface identifies the email sender different than the service provider.

Thus, the applied prior art teaches a first computer configured to receive a communication from second computer, where the communication indicates that the communication recipient (user) should be permitted to receive communications from a sender over a communication channel other than the channel through which the communication was received.

12. Applicant's argument filed on the above-mentioned amended has been fully considered but not rendered persuasive.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Hand carried or delivered to:

Customer Service Window located at the Randolph Bldg.  
401 Dulany St.  
Alexandria, VA 22314

Faxed to the Central Fax Office:

(571) 273-8300 (New Central Fax No.)

Or Telephone:

(571) 272-2100 for TC 2100 Customer Service Office.

B. Prieto  
Primary Examiner  
TC 2100  
June 15, 2006

*Beatriz Prieto*  
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